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No.

In the Supreme Court of the United States

OCTOBER TERM, 1984

DEERE & COMPANY,

Petitioner,

vs.

JON E. KINZENBAW and
KINZE MANUFACTURING, INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

This petition presents the following questions:

1. Does not the decision of the Federal Circuit in this case, by resolving only the issue of infringement of the Pust patent without passing on the issue of whether that patent is unenforceable by reason of inequitable conduct, deprive Deere of its property rights in the Pust patent without due process of law where Deere was denied appellate review of a finding that bars enforceability against other infringers?

2. Did not the Federal Circuit, in failing to rule on whether the Pust patent had been procured by inequitable conduct, let stand a decision holding unenforceable that patent on evidence that was indisputably insubstantial?

3. Does not the decision of the Federal Circuit respecting the issue of infringement of the Pust patent conflict directly with the decision of this Court in *Graver Tank & Manufacturing Co., Inc.* v. *Linde Air Products Co.* (1950), 339 U.S. 605, with respect to a matter of great importance, namely when and under what circumstances a patent is entitled to application of the doctrine of equivalents where the patent limitation not satisfied by the infringing device is clearly an unnecessary limitation?

4. Whether the Federal Circuit erred in ruling that Deere had waived its right to challenge, on the ground of sufficiency of evidence, findings that Deere's Hansen and Brass-Hansen patents were invalid over earlier unpublished ideas of others where:

(a) Deere did make a timely objection to the instruction tendered on that otherwise unpleaded

defense when it was first raised, on the ground that there was no evidence to support it; and,

(b) Congress has amended the law, making such unpublished prior ideas irrelevant to patentability as a matter of law, in any event?

5. Does not the decision of the Federal Circuit in this case conflict directly with the decision of this Court in *City of Elizabeth* v. *American Nicholson Pavement Co.* (1877), 97 U.S. 126, with respect to a matter of great importance in the Patent Law, namely whether the experimental use doctrine is still the law of this country?

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RULE 28.1 STATEMENT

Petitioner Deere & Company has no parent companies or subsidiaries apart from wholly-owned subsidiaries or affiliates.

IN THE

SUPREME COURT OF THE UNITED STATES

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DEERE & COMPANY,

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JON E. KINZENBAW and
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Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit in its consolidated cause Nos. 83-1424 and 84-523. The judgment was entered August 7, 1984; rehearing was denied September 19, 1984.

OPINIONS BELOW

The opinion of the Court of Appeals has been reported at 741 F.2d 383 and is reprinted *infra* at p. 1a. The District Court filed no opinion, entering judgment on the jury's verdict. The only District Court opinion, not

officially reported, was on motions of both parties for judgment n.o.v.; that decision is reproduced in the appendix to this petition, commencing at page 18a.

JURISDICTION

The judgment of which review by this Court is sought was entered on August 7, 1984, and rehearing was denied on September 19, 1984. This Court has jurisdiction by virtue of 28 U.S.C. §1254(1).

THE CONSTITUTIONAL PROVISIONS, STATUTES AND RULES INVOLVED

U.S. Constitution, Amendment V

> "No person shall . . . be deprived of life, liberty or property, without due process of law. . . ."

35 U.S.C. §103

Conditions for Patentability; Non-obvious Subject Matter

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."
>
> "Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person

or subject to an obligation of assignment to the same person."

35 U.S.C. §102(b)

Conditions for Patentability; Novelty and Loss of Right to Patent

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . ."

Rule 50, Federal Rules of Civil Procedure

Motion for a Directed Verdict and for Judgment Notwithstanding the Verdict

"Whenever a motion for directed verdict made at the close of all the evidence is denied or for any reason is not granted, the court is deemed to have submitted the action to the jury subject to a later determination of the legal questions raised by the motion. . . . a party who has moved for a directed verdict may move to have the verdict and any judgment entered thereon set aside and to have judgment entered in accordance with his motion for directed verdict. . . ."

STATEMENT OF THE CASE

This proceeding was commenced in the United States District Court for the Northern District of Iowa, Cedar Rapids Division, on a complaint by plaintiffs Kinze Manufacturing, Inc. and its president and sole owner Jon E. Kinzenbaw (hereinafter collectively "Kinze"). The original complaint named Deere & Company (hereinafter "Deere") as the defendant, and prayed for declaratory judgment that Deere's two U.S. patents, Pust

No. 3,499,495 and Brass-Hansen No. 4,009,668 were invalid and not infringed by Kinze's manufacture and sale of crop planters.*

Responding to the complaint, Deere moved to dismiss the antitrust, misuse and breach of contract actions, and, at the same time, filed a counterclaim for patent infringement and unfair competition. In that counterclaim, Deere charged Kinze with infringement of the Pust and Brass-Hansen patents named in the complaint, plus Hansen patent No. 3,552,601 and Brass patent No. 3,982,670.**

The Deere patents are all directed to a planting machine marketed by Deere under the name "Max-Emerge". (Such machines may plant seeds in a single row, or may embody an array of row planters mounted side-by-side on a common frame, each row planter being referred to by farmers as a "planter unit" or "row unit".)

From the time that the Max-Emerge planter was publicly introduced by Deere on July 18, 1974, it enjoyed unprecedented success, soon becoming the market leader. So advanced were the Deere row units that Kinze, in pleadings filed in this case, admitted that they were:

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* The complaint, later amended, also alleged violations of the antitrust laws, patent misuse and breach of contract; those matters are no longer in issue.

** Deere's counterclaim also included another Hansen patent and a patent owned by a Kentucky farmer named Eugene G. Keeton. The other Hansen patent was dropped before trial, while the Keeton patent, exclusively licensed to Deere, was held invalid by the District Court. Because the Keeton patent expired before Deere's appeal was heard in the Court of Appeals, the judgment as to Keeton was vacated as moot.

> ". . . acknowleged to possess significant advantages over the row units sold by competitors . . . and Deere row units are preferred over those of all competitors in the Corn Belt states and especially in the State of Iowa. The situation has existed from approximately 1974 to the present."

Farm literature at the time of the Max-Emerge introduction was no less laudatory, characterizing the Max-Emerge concept of planting as a "radical departure" from earlier planters.

The highest tribute to the Max-Emerge row units was paid by the most unlikely source, John E. Kinzenbaw himself, who described them as "unsurpassed" because of the "combination of elements" they contained. In fact, it was because the Max-Emerge row units were "unsurpassed" that Jon Kinzenbaw, on the advice of his lawyers that Deere's patents were invalid, vowed to copy Deere's patented row unit "bolt for bolt"; and that is exactly what he did.

The trial commenced on March 7, 1983, before an Iowa jury. It soon became evident that Kinze, without interference from and, indeed, with the tacit blessing of, the District Judge, was trying Deere personally rather than its patents.*

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* The jury was reminded, again and again, that Deere's annual sales approached $5 billion; in the closing argument, Kinze again emphasized the point by telling the jury "nobody sympathizes with a millionaire". (Kinze, of course, never told the jury that its piracy catapulted Jon Kinzenbaw to immense personal wealth.) Deere's patents were likened to counterfeit "Purple Hearts" which were bought instead of earned; and Deere itself was likened to "the guy who's driving down the street recklessly and hits a little child."

Kinze profited handsomely from tireless insistence that "big" is "bad" and that Deere's success justified piracy. The jury verdict consisted of answers to forty-odd special interrogatories, declaring, in sum, that four of the five patents were obvious and/or otherwise defective and that the fifth (plus one of the others) had been obtained by inequitable conduct in the Patent Office. The jury also found that four of the five patents had been infringed.

While commenting that the evidence presented by Kinze was "thin", the District Court adopted *in toto* the jury's answers to the special interrogatories and entered judgment accordingly. Both sides moved for judgment notwithstanding the verdict, but those motions were all denied. A final amended and substituted judgment embodying the District Court's rulings was entered on October 3, 1983.

Deere appealed to the United States Court of Appeals for the Federal Circuit; that court affirmed the judgment of the District Court in all respects, save for vacating, on the ground of mootness, the judgment respecting the Keeton patent. Anent the Hansen and Brass-Hansen patents in suit, the Court of Appeals held that Deere had waived its rights to move for judgment n.o.v. on the ground of insufficient evidence, because Deere did not include, in its motion for directed verdict, any specific challenge to Kinze's last-minute contention that the inventions claimed in those two patents were publicly known or used in this country before they were invented by the patentees. On that point, the Court of Appeals found:

(a) When Deere was confronted, at an instructions conference, with Kinze's proposed instruction raising that defense, Deere insisted that there was "no evidence in the case".

(b) The proffered defense had not been raised in the pretrial order.

(c) The District Court had not ruled on Deere's objection to the instruction when Deere presented its oral motion for a directed verdict.

The Court of Appeals held that Deere was not justified in drafting its motion for directed verdict in reliance on the pretrial order and that Deere should have foreseen that the District Court would permit Kinze to add an otherwise unpleaded defense to the case while an objection to it was still under advisement, thus concluding that Deere had not preserved for appeal the issue of the sufficiency of the evidence.

The Court of Appeals affirmed also the holding of the District Court that the Pust patent in suit had not been infringed; and it did not even review the jury's finding that the Pust patent was unenforceable by reason of inequitable procurement. (That finding was in fact without *any* evidentiary support.)

Finally, the Court of Appeals, in disregard of this Court's holding in *City of Elizabeth* v. *American Nicholson Pavement Co.* (1877) 97 U.S. 126, held the Brass patent invalid because its subject matter was allegedly in public use more than a year before the patent was applied for.

REASONS FOR GRANTING THE WRIT

This Court should issue the writ of certiorari in this case because it involves four of the most serious issues plaguing this country's patent system.

The Court of Appeals for the Federal Circuit was established in 1982 by Congress in the Federal Court's Improvement Act. For the first time, a single court of appeals had jurisdiction to eliminate the many inconsistencies created by the disparate decisions of the regional courts of appeals. The early decisions of the new court delighted all those who believe in the patent system — litigants and the patent bar alike. No longer did it matter whether a patentee or an accused infringer had his place of business in a circuit wherein patents were virtually never upheld (such as the 8th and 9th Circuits) or a circuit known to be a "pro-patent" circuit (such as the 5th and 7th Circuits). So too it no longer mattered whether a patentee was a large, successful corporation or an individual inventor seeking to enforce his patent against a corporation.

The Court of Appeals for the Federal Circuit, when it set out to interpret the Patent Laws of this country uniformly, took pains to define, in precise terms, the quantum and quality of evidence required to defeat a patent's statutory presumption of validity. Leading the way on that score was the Court's decision in *Connell* v. *Sears Roebuck & Co.* (Fed.Cir., 1983), 772 F.2d 1542. There, addressing the controversial subject of the use of juries in complex patent cases, Chief Judge Markey noted (722 F.2d at p. 1546):

> "Jury verdicts must be treated with great deference. The Seventh Amendment to the Constitution pre-

> serves the right to trial by jury in suits at common law and also provides that United States Courts shall not re-examine facts tried by jury except under the rules of common law."

Chief Judge Markey added (722 F.2d at p. 1549):

> "The patent challenger may indeed prove facts capable of overcoming the presumption, but *the evidence relied on to prove those facts must be clear and convincing.* Thus, the introduction of art or other evidence not considered by the PTO does not change the burden and does *not* change the requirement that *that evidence establish presumption—defeating facts clearly and convincingly.*"

Thus the Federal Circuit, while noting in *Connell* that jury verdicts in patent cases "must be treated with great deference", held that a reviewing court ". . . must inquire, under the proper legal standard of patentability, whether the evidence and inferences reasonably drawn therefrom" are sufficient to "establish presumption-defeating facts clearly and convincingly."

The Federal Circuit's *Connell* opinion tacitly acknowledged that many litigants, in complex patent actions, demand a jury for reasons wholly unrelated to the merits of their cause, just as Kinze did here. Kinze, a cynical infringer who pirated the patented Deere row unit, based its case on the "little guy" status against the behemoth Deere, trying Deere "personally" throughout the trial, even to the point of comparing Deere to "the guy who's driving down the street recklessly and hits a little child".

A party to a *patent* case, whether it be the patentee or the accused infringer, abuses the patent system and

the jury system by resorting to that sort of emotional tactics. The *Connell* rule is mandated not only by the statutory presumption of validity, but also by the imperative need to avoid abuses of the jury system such as occurred here. (Chief Judge Markey said essentially that in *E.I. duPont & Co.* v. *Berkley & Co.* (8th Cir., 1980), 620 F.2d 1247, 1275.)

Unaccountably, the Federal Circuit, in its review of this case, abandoned its requirement that one attacking the validity of a patent must adduce evidence establishing "presumption-defeating facts clearly and convincingly". By refusing in this instance to review the sufficiency of the evidence under the *Connell* standard, the Federal Circuit has condoned and rewarded Kinze's shabby trial tactics.

Not only did the Federal Circuit refuse to follow its own *Connell* standard, so too did it cast aside the enlightened doctrines announced by this Court in *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.* (1950), 339 U.S. 605 and *City of Elizabeth* v. *American Nicholson Pavement Co.* (1877), 97 U.S. 126.

In demonstrating that this case cries out for this Court's review, we make the following points.

I. The Federal Circuit Deprived Deere Of Its Property Rights In The Pust Patent Without Due Process; The Record Proves That The Pust Patent Is Enforceable And Was Infringed.

The Federal Circuit, ignoring the jury's finding that the Pust patent was procured by inequitable conduct, affirmed the District Court with respect to the District Court's refusal to apply the doctrine of equivalents on the infringement issue. While that action may have dis-

posed of the Pust patent so far as Kinze is concerned, it deprived Deere of its day in Court in respect to the inequitable conduct finding. That was a denial of due process, as will now be shown.

A. Due Process Demands That The Federal Circuit Review And Resolve The Inequitable-Conduct Issue Independent Of The Infringement Issue.

Elementary is the principle that a patent is property just as is land (*Consolidated Fruit Jar Co.* v. *Wright* (1876), 94 U.S. 92, 96), of which an inventor cannot be deprived without due process of law. The Court of Appeals for the Fourth Circuit put it well in *Iowa State University Research Foundation* v. *Sperry-Rand Corp.* (4th Cir., 1971), 444 F.2d 406, 409:

> "The patentee has a vested property right that can be canceled, revoked, or annulled only by judicial proceedings that afford due process of law."

Because the Pust patent has several more years of life before it expires, the Federal Circuit, in failing to review the inequitable-conduct finding respecting that patent, has stripped Deere of its property right in the Pust patent without even a pretense of a day of court.

For many years, an inventor was permitted to assert the claims of his patent against a second infringer even though those very claims had previously been held invalid in an earlier action (*Triplett* v. *Lowell* (1936), 297 U.S. 638). But the law today is otherwise (*Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation* (1971), 402 U.S. 313). Under *Blonder-Tongue,* Deere is barred by collateral estoppel from ever asserting the Pust patent against another infringer — even though it

has been denied appellate review of the inequitable-conduct finding.

That clearly violates the due-process clause of the Fifth Amendment.

B. The Jury's Finding Of Inequitable Conduct Was Based On Evidence So Insubstantial That The Federal Circuit Must Surely Have Set It Aside Had Deere Been Granted A Hearing.

The Pust patent had its origin in the plains of Montana, when farmer Waldo Pust was planting seeds with a planter which cuts its furrow with a pair of angled discs which formed a "V" at the point where they entered the ground. Pust realized that soil was being lifted by the discs as they emerged from the ground, thus resulting in non-uniform layers of soil covering the seeds he had just planted. Because the soil covering the seeds was often dry, the seeds did not sprout.

The Oliver planter Pust was using had "gauge wheels" which controlled furrow depth; Pust solved the problem by moving his gauge wheels rearwardly so they pressed on the soil at the point where the discs emerged from the ground. And that simple alteration, Pust learned, resulted in vastly improved performance. The repositioned gauge wheels held the soil in place and yielded a far better furrow.

In due course, Pust obtained a patent in which he acknowledged that his invention resided in "the arrangement of the discs and scraper wheels", rather than in any new hardware.

Having no prior art against the Pust patent apart from that which the Patent Office had considered before grant-

ing the patent, Kinze's attack on the Pust patent was a totally unfounded charge of "inequitable conduct". Kinze did not even dispute the meritorious nature of Pust's invention; its lawyer-expert witness Donald Zarley, who argued the case from the witness stand, admitted that:

> ". . . Pust made a patentable improvement."

Notwithstanding that admission, the jury, swayed by Kinze's repeated appeals to prejudice, found that the Pust patent had been procured by inequitable conduct, and the District Court adopted the jury's finding. To ensure Pust's demise, the District Court held Pust non-infringed, refusing to invoke the doctrine of equivalents.

In failing even to inquire whether the evidence on which the jury reached its inequitable-conduct finding was sufficient under the *Connell* standard, the Federal Circuit let stand a shocking miscarriage of justice; and its failure to scrutinize that finding was doubly shocking because, had the finding been appraised at all, it would surely have been struck down.

The finding, and the judgment based on it, had no foundation except an unsound legal theory — the notion that Pust had a duty to identify explicitly in his Patent Office papers the manufacturer's name and model number of the Oliver planter which Pust modified in making his invention. The unsoundness of that theory — and the lack of any factual basis for it — was exposed by the cross-examination of Kinze's lawyer-witness Zarley:

> (1) Zarley acknowledged that Pust told the readers of his patent that the novelty of his invention resided solely in the repositioning of old elements rather than in the hardware employed.

(2) Zarley admitted that a patent to Cole — considered by the Patent Office — disclosed every relevant feature of the old Oliver planter, establishing beyond dispute that the Oliver planter was no more pertinent than the prior art before the examiner.*

(3) Zarley admitted he knew of no rule requiring an inventor to identify prior art in terms of the manufacturer's name and model number.

The Federal Circuit did not even allude to jury's finding of inequitable conduct in respect to the Pust patents or to the above-noted admissions which stamp the finding "Counterfeit".

C. The Federal Circuit, In Refusing To Apply The Doctrine Of Equivalents, Failed To Follow Established Precedent Of This Court.

This Court has long recognized that the determination of infringement is not restricted to the literal language of a patent claim. In *Graver Tank & Manufacturing Co., Inc.* v. *Linde Air Products Co.* (1950), 339 U.S. 605, Mr. Justice Jackson wrote (at 607):

> ". . . courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for — indeed encourage — the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing,

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* The jury, to its credit, found that Pust made a patentable improvement over the Oliver planter. But having made that finding, the jury concluded that Pust's attorney misbehaved in not citing the Oliver planter by name and model number.

> would be enough to take the copied matter outside the claim, and hence outside the reach of law."

In this case, Pust's patent claims recite that the radius of the gauge wheel is less than the radius of the discs. Kinze, because its gauge wheels were about one-tenth of an inch larger in radius than its discs, did depart from the literal language of the Pust claims, but without affecting the machine operation in any degree whatever. Jon Kinzenbaw himself admitted that the size of the gauge wheel relative to the disc "doesn't make any difference".

On these undisputed facts, the words of Justice Jackson are especially pertinent (339 U.S., at 612):

> "It is difficult to conceive of a case more appropriate for application of the doctrine of equivalents. . . . Without some explanation or indication that Lincolnweld was developed by independent research, the trial court could properly infer that the accused flux is the result of limitation rather than experimentation or invention."

In this case, the District Court need not infer that Kinze's slightly larger gauge wheel was the result of imitation rather than experimentation; John Kinzenbaw proclaimed that he had copied, "bolt for bolt", the whole Deere planter. It was the only one farmers would buy!

The Federal Circuit refused to apply the *Graver* doctrine to the Pust patent because Pust had added the limitation respecting gauge-wheel size during the prosecution of the patent. But that, as the record in the District Court proved, did not distinguish the Pust invention in any way from the prior art. The Cole and other prior-art patents considered by the Patent Office de-

scribed a gauge wheel which was smaller than the disc, so the recited gauge-wheel size was a clearly unnecessary limitation.*

The Pust patent *was* infringed by Kinze under the doctrine of equivalents.

II. The Ruling Of The Federal Circuit On The Hansen And Brass-Hansen Patents Runs Contrary To The Weight of All Authorities And Contrary To The Mandate Of Congress.

The Federal Circuit held that Deere could not challenge on appeal the District Court's denial of its motion for judgment n.o.v. on the ground of insufficient evidence, because Deere did not include, in its motion for a directed verdict, a specific challenge to Kinze's last-minute contention that the subject matter of the Hansen and Brass-Hansen patents was publicly known or used in this country before its invention by the patentees.**

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* Deere has always recognized that its row unit utilizes Pust's invention, even though its gauge wheels are likewise about one-tenth of an inch larger than the radius of the discs. Kinze duplicated Deere's gauge wheel, not to avoid Pust's literal language, but to produce a row unit that was identical to Deere's.

** Well after the trial began, Kinze concocted the theory that the subject matter of the Hansen and Brass-Hansen patents was unpatentable over ideas that Keeton and Pust had when they made their patented inventions but did not disclose in their patents. Demonstrating that the jury voted for Kinze out of prejudice rather than reason is the fact that the trial testimony showed that neither Keeton nor Pust ever communicated their private ideas to Deere — a fact pivotal to Kinze's defense. When Kinze

Deere insisted that there was "no evidence" in the case tending to prove that the subject matter of the Hansen and Brass-Hansen patents was publicly known or used by others before the patentees invented it. Deere accordingly objected to the instruction tendered by Kinze on that purported defense; and *that* satisfied both the spirit and the letter of Rule 50, F.R.C.P., which requires only (a) an explicit motion for directed verdict or (b) an objection to a proposed instruction on the ground that supporting evidence is lacking (*Rochester Civic Theater, Inc.* v. *Ramsay* (8th Cir., 1966), 368 F.2d 748, 752-3).

In this case, Deere did object to Kinze's proposed instruction on the ground that there was no evidence to support the "known or used" defense, and that objection preserved Deere's rights on appeal. As the court wrote in *Bohrer* v. *Hanes Corporation* (5th Cir., 1983), 715 F.2d 213, 217:

> "To demand a slavish adherence to the procedural sequence and to require these defendants, in this case, to articulate the words of renewal once the motion had been taken under advisement, would be 'to succumb to a nominalism and a rigid trial scenario as equally at variance as ambush with the spirit of our rules'."

Be it not forgotten: Deere did move for a directed verdict based on all the issues specified in the pretrial order;

** (Continued)
was called upon in the Federal Circuit to support the jury's finding of invalidity on the stated ground, it argued that it was entitled:

> ". . . to the inference stemming directly from the jury's verdict on this issue that Keeton in fact disclosed all relevant details about his meter to the Deere engineers."

Kinze thus argued in the Federal Circuit that a verdict can raise an inference which will itself support that verdict. Clear and convincing evidence indeed!

the "publicly known or used" defense was never in the pretrial order, and the District Judge had not yet ruled whether he would permit the issue to be raised. (Even so, as noted, Deere did object strenuously to Kinze's proposed instruction on the issue, on the ground that the instruction had no evidentiary support.)

In sum, the Federal Circuit held (1) that Deere was not justified in drafting its motion for directed verdict in reliance on the pretrial order, and (2) that, even though the objection to Kinze's unpleaded defense was under advisement, Deere should have foreseen that the District Court would overrule that objection and permit Kinze to add that defense.

Deere most surely was deprived of its day in Court. To hold, as the Federal Circuit did, that Deere had waived its right to have the jury's findings reviewed on appeal when all authority holds that Deere, by objecting to the instruction, had preserved the point for appeal, is just outrageous.

Wholly apart from the unfairness of the Federal Circuit's decision, it allowed to stand the finding that the Hansen and Brass-Hansen patents were invalid on the strength of unpublished private ideas in the minds of two individuals who also owed an allegiance to Deere. The law now in effect does not allow that result. In the Patent Law Amendments Act of 1984, H.R. 6286, Congress has decreed that subject matter developed by another person is *not* prior art as to an invention owned by the same party.* The law explicitly provides that:

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* The Patent Law Amendments Act of 1984 provided, in §106, that the amendments shall apply to any patent, including those in litigation, unless the time for filing appeal had already expired on the date of enactment.

> "Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

In sum, the "prior art" on which the Federal Circuit allowed the Hansen and Pust patents to be invalidated was alleged prior — but unpublished — knowledge of Eugene Keeton and Waldo Pust, *both* of whom had conveyed to Deere their ownership interests in their respective inventions. And under the Congressional mandate of 35 U.S.C. §103, as amended, the alleged "prior knowledge" of Keeton and Pust was *not* prior art against the Hansen and Brass-Hansen patents, respectively.

Because the new law did not take effect until after the Federal Circuit had ruled, this Court is Deere's only hope to insure that the Congressional mandate of §103 is carried out. This Court should vacate the Federal Circuit's ruling respecting the Hansen and Brass-Hansen patents as contrary to the clear mandate of Congress as embodied in the Patent Law Amendments Act of 1984.

III. The Federal Circuit's Ruling On The "Public Use" Issue Is Inconsistent With Long-Standing Decisions Of This Court.

Another major error in the decision of the Federal Circuit was its refusal to set aside the jury's finding that the Hansen and Brass-Hansen patents had been in "public use" under §102(b). In fact, the Federal Circuit commented not at all on the jury's finding that the Brass-

Hansen patent had been in public use, restricting its comments to the Brass patent.*

Deere, the record showed, utilized the services of farmers to test its planters before they were introduced to the marketplace. The reason for going "outside" was that Deere simply did not have under its control the wide variety of conditions of weather, soil and terrain in which the planters had to be tested before the planter merited the John Deere label. And because only a small window of time is available for the testing of a planter — about a month every spring — Deere, like the farm-equipment business has historically done, placed machines in the hands of farmers for testing. Deere's engineers, however, exercised at all time close supervision over the testing, retaining control of and monitoring placement and operation of the machines. Farmers participating in the test program were told (a) that the

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* The jury's finding of public use is just another example of how the jury voted with their emotions instead of their minds. The District Court instructed the jury that it could find a "public use" if it found any non-secret use of the invention. There was literally no evidence tending to prove that Deere's testing activities, on which the charge of public use was based, was non-secret. Kinze admitted that, exhorting the jury to assume that the farmer's who had tested Deere's planters had violated their secrecy commitment:

> "Hey, did we have a hood over you? Did your friends see it? Aren't you proud to be the one that's — to have the new Max-Emerge planter? What little I know about farmers, they sure as heck would be proud of it."

We have here another sterling example of "clear and convincing evidence"!

machines were experimental, (b) that they must report to Deere's engineers all problems encountered, (c) that they were to use the machine in confidence and not discuss or allow friends and neighbors to see the machine and (d) that they were not to make any changes on the machine. None of the test machines was ever sold, each being returned to Deere for a complete tear-down analysis.

The use of Deere's machines by farmers was not "public". No evidence even suggested that the farmers' obligation of secrecy, imposed on them by Deere, was ever broken.

On these facts, this Court's decision in *City of Elizabeth* v. *American Nicholson Pavement Co.* (1877), 97 U.S. 126 controls. In that case, Mr. Justice Bradley wrote (97 U.S., at 136):

> "It is not public knowledge of his invention that precludes the inventor from obtaining a patent for it, but public use or sale of it."

In this case, the testing of the Deere machines was, by no stretch of the imagination, "public".

The Federal Circuit ruled that the farmers' secret testing of the Deere machines amounted to a "public use", on the theory that such testing served Deere's commercial purposes — a conclusion plainly based on a misapprehension of the law. Every case cited by the Federal Circuit in support of that proposition involved not only a secret use of a process later patented but also the *sale* of a product made by that process. See, for example, *Metallizing Engineering Co.* v. *Kenyon Bearing And Automotive Parts Co.* (2nd Cir., 1946), 153 F.2d 516.

Deere's testing did not result in Deere's sale of anything; the record proved the contrary, for the test machines were returned to Deere where they were evaluated and then destroyed. None was ever sold.

All else aside, the conclusion of the Federal Circuit just flies in the face of the "experimental use" doctrine announced in *City of Elizabeth* v. *American Nicholson Pavement Co.* (1877), 97 U.S. 126. Deere's testing activities in this case were addressed not only to the mechanical performance of the machines but their durability as well. On that very point, Mr. Justice Bradley wrote (97 U.S., at 135):

> "If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And, though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use, within the meaning of the statute."

Unaccountably, the Federal Circuit has just refused to follow *City of Elizabeth,* and its failure in that regard has reached epidemic proportions. See, for example, *Pennwalt Corporation* v. *Akzona Incorporated* (Fed. Cir., 1984), 741 F.2d 1573.

It is time for this Court to intervene by reaffirming the principles of *City of Elizabeth,* and thus restore order to the law of experimental use.

Conclusion

Deere deserves no special consideration because it is a large and successful business entity, but on the other hand, it should not be penalized, as it was in the courts below, because of its size and success.

Kinze's copying of the Max-Emerge planter was a "rip-off" of the property rights which Deere had acquired — and to which it was entitled — in that planter, and the stamp of approval given to Kinze's copying by the jury, the District Court and the Court of Appeals for the Federal Circuit constitutes a deprivation of those property rights without due process of law.

This is a case in which this Court's supervision is desperately needed, and petitioner accordingly prays, most urgently, that the writ of certiorari be issued.

Respectfully submitted,

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APPENDIX

JON E. KINZENBAW and KINZE MANUFACTURING, INC.,
Appellees,

v.

DEERE & COMPANY and EUGENE G. KEETON,
Appellants.

Appeal Nos. 83-1424, 84-523.
United States Court of Appeals, Federal Circuit.

Aug. 7, 1984.

In patent action, the United States District Court for the Northern District of Iowa, Edward J. McManus, Chief Judge, entered judgment on jury verdict finding that all five patents in question either were invalid, unenforceable, or not infringed, and appeal was taken. The Court of Appeals, Friedman, Circuit Judge, held that: (1) patent holder waived his right to challenge on appeal court's denial of its motion for judgment notwithstanding the verdict on issue of prior public use or knowledge as basis of invalidity of one patent; (2) doctrine of prosecution history estoppel precluded patent holder from relying upon doctrine of equivalents by means of establishing infringement of one of its patents; and (3) prior commercial use barred issuance of third patent.

Affirmed in part, vacated in part and remanded.

1. Federal Civil Procedure — 2602

If party fails to specify issue in its motion for directed verdict, it may not subsequently challenge jury's right on that issue, which is conclusive on that point. Fed. Rules Civ. Proc. Rule 50(a), 28 U.S.C.A.

2. Federal Civil Procedure — 2602

Specific reference to issue in motion for judgment notwithstanding the verdict does not cure prior failure to include issue in motion for directed verdict and, thus, does not preserve issue for appeal. Fed. Rules Civ. Pro. Rule 50(a), 28 U.S.C.A.

3. Patents — 324.1

Where patent holder was on notice that alleged infringer contended that issue of prior public knowledge or use was in the case and that court might allow jury to consider that issue, and patent holder did not refer to prior public use issue in its motion for directed verdict, although it did specifically refer to number of other issues, patent holder waived its right to challenge on appeal court's denial of its motion notwithstanding the verdict on issue of prior public knowledge or use. Fed. Rules Civ. Proc. Rule 50(a), 28 U.S.C.A.

4. Patents — 237

Doctrine of equivalents is designed to protect investors from unscrupulous copies and unanticipated equivalents.

5. Patents — 168(2)

Where alleged infringer did not endeavor to avoid patent by making minor and material changes in what inventor had invented, but rather, adopted very element that inventor had eliminated for stated purpose of avoiding examiner's rejection and obtaining patent, patent holder was precluded by doctrine of prosecution history estoppel from relying upon doctrine of equivalents to establish infringement.

6. Patents — 75

Commercial use is "public use" of invention for nonpatentability purposes even if it is kept secret. 35 U.S.C.A. § 102(b).

7. Patents — 75

While secrecy if one factor to be considered in determining whether use of invention was experimental or public, secrecy alone does not necessarily negate public use. 35 U.S.C.A. § 102(b).

8. Patents — 75, 80

Where patent holder disavowed any claim that farmers' use of its patented row planters was experimental, testing of machines was "commercial use" of patented invention; thus, as commercial use occurred more than one year before filing application for patent, issuance of patent was barred. 35 U.S.C.A. § 102(b).

See publication Words and Phrases for other judicial constructions and definitions.

Dugald S. McDougall, Chicago, Ill., argued for appellants. With him on the brief were Theodore R. Scott and Keith V. Rockey, Chicago, Ill., and Donald G. Ribble, Cedar Rapids, Iowa, of counsel.

James J. Hill, Chicago, Ill., argued for appellee. With him on the brief were Duane Burton, Denver, Colo., and Paul J. Petit, Chicago, Ill. of counsel.

Before MARKEY, Chief Judge, and FRIEDMAN, RICH, DAVIS and BALDWIN, Circuit Judges.

FRIEDMAN, Circuit Judge.

This is an appeal from a judgment of the United States District Court for the Northern District of Iowa after a jury trial in a patent infingement case. The jury, in response to special interrogatories, found that each of the five patents in issue was either invalid, unenforceable, or not infringed. The trial court entered judgment on that verdict. We affirm most of the judgment, but vacate one portion of it as moot.

I

Appellant Deere & Company (Deere) owns four of the patents involved: U.S. Patent No. 3,552,601 to Hansen (Hansen patent); U.S. Patent No. 3,499,495 to Pust (Pust patent); U.S. Patent No. 4,009,668 to Brass and Hansen (Brass-Hansen patent); and U.S. Patent No. 3,982,670 to Brass (Brass patent). Appellant Keeton owns the remaining patent, U.S. Reissue Patent No. 27,578 (Keeton patent) and Deere holds an exclusive license under it from Keeton.

All five patents cover elements of a row planter, an agricultural machine that, when pulled by a tractor, opens a furrow in the soil, places seeds at appropriate intervals in the furrow, and loosely covers the seeds with moist earth. In order to help farmers optimize their yield, row planters have become rather complex machines.

The planters must produce a furrow that consistently maintains the proper depth for planting the seed. If the machine plants the seeds too deeply, the young plant will require more time to push its way above the surface and thus will not mature as rapidly. A seed planted too shallowly may be surrounded by the drier earth near the surface and thus take more time to germinate, again resulting in delayed maturity. The machine must also eject only one seed at each interval. If the machine ejects two seeds, two plants may grow too close together and compete with one another for light, water and nutrients. If the machine does not eject a seed at a given point, the farmer's yield is reduced because no plant grows where the soil could have supported one.

Finally, the machine must cover the seed with moist, loosely packed earth. If the soil above the seed is packed too tightly, it may slow the young plant's ability to break through the surface. If the machine packs dry earth around the seed, the seed will not germinate as quickly.

Each of the patents involved in this suit deals with a way to minimize at least one of the problems described above. The Keeton patent covers an apparatus for selecting one seed from among a group of seeds. The Hansen patent describes various improvements upon the Keeton device. The Pust patent covers an apparatus for preventing dirt from falling into the furrow once it is cut, thus maintaining constant width and depth in the furrow. The Brass-Hansen patent describes an improvement upon the Pust invention. The Brass patent describes a means for driving the seed ejector.

A row unit, described above, plants a single row of seeds in a field. Farmers generally prefer to haul more than one row unit behind their tractors. In this way they can plant twelve or more rows at one pass. In order to attach more than one row unit to the tractor, however, farmers must use a "tool bar," which attaches to the tractor like a trailer. Many row units can then be attached to the tool bar at suitable intervals.

Appellee Kinze Manufacturing, Inc. (Kinze) produced and sold a rear-folding tool bar. In order also to sell a complete planter to farmers, Kinze bought row units from Deere and sold them attached to its tool bar. Kinze encountered some difficulty, however, in obtaining enough Deere row units, apparently because Deere preferred to sell the units attached to its own tool bar.

Kinze sued Deere in 1977, alleging that Deere's selling of its patented row unit together with its unpatented tool bar constituted an illegal tying arrangement. In settlement of that suit, Deere agreed to provide Kinze with row units that it could sell in conjunction with its tool bars.

Despite this agreement, Kinze still could not obtain enough Deere row units. When Kinze's attorneys advised that Deere's patents were invalid, Kinze began producing a row unit similar to Deere's.

Kinze then instituted the present suit against Deere. Kinze again alleged that Deere's sale of its patented row planter in combination with its unpatented tool bar was an illegal tying arrangement in violation of the antitrust laws. Kinze also charged Deere with a breach of the 1977 settlement agreement. The complaint also sought a declaratory judgment that the Pust and Brass-Hansen patents were invalid and not infringed.

Deere filed a counterclaim alleging that Kinze had infringed each of the five patents listed above and also had engaged in unfair competition. It sought injunctive relief and damages. The patent issues were separated from the other issues in the case for trial.

The court submitted to the jury 13 special interrogatories broken down into a total of 35 subparts. Each subpart asked the jury to decide one of the issues regarding one of the patents involved in the case. For example, interrogatory 4 asked:

> Was the subject matter of the claims of the following patents publicly known or used by others in this country before the claimed invention was made by the patentee? ("Yes" is a vote for Kinze, "No" for Deere).

Patent	Your Answers	
Hansen '601	YES.....	NO.....
Brass-Hansen '668	YES.....	NO.....

The jury decided 18 of the questions in Deere's favor and 17 in Kinze's favor. The jury found for Kinze on at least two grounds concerning each patent. Thus, each of Deere's patents was found to be either invalid, unenforceable, or not infringed. The court entered judgment in accordance with the jury's answers to the interrogatories. The judgment held that the Keeton, Hansen, Brass-Hansen, and Brass patents are invalid and that the Pust and Brass-Hansen patents are unenforceable, and dismissed Deere's counterclaim "on the merits."

Deere filed a motion for judgment notwithstanding the verdict (n.o.v.) on the ground that the jury's determinations were not supported by clear and convincing evidence. The district court denied the motion. It stated:

> Judgment N.O.V. is proper only if reasonable persons, viewing the evidence in the light most favorable to sustaining the jury's verdict and giving the prevailing party the benefit of all reasonable inferences, could not differ as to the conclusion reached.
>
> Here, a review of the record discloses that each factual question was genuinely contested in the record and hence, properly submitted to the jury for their consideration. It is for the jury, not the court, to resolve questions about conflicting evidence and questions as to the weight and credibility of witnesses. Although the jury might have found to the contrary, on any issue which it considered, it was not required to do so by the law. Moreover, as this court has previously indicated, each of the jury's findings were [sic] supported by the evidence.

Kinzenbaw v. *Deere & Co.*, No. C 80-20, slip op. at 2-3 (N.D. Iowa Aug. 24, 1983) (citations omitted).

II

Before this court, Deere makes a sweeping attack upon the jury's determinations. It tells us that "not a single one of the jury findings that Deere is challenging on this appeal had substantial evidentiary support." This charge seems somewhat implausible in view of the fact that the jury decided 18 of the questions in favor of Deere and only 17 in favor of Kinze. The verdict did not indicate that the jury took a one-sided view of the evidence. In any case, the record does not support this allegation.

As noted, the jury decided against Deere on at least two grounds on each of the five patents at issue. Deere

challenges each of the jury's determinations on each of the patents adverse to it. We find it unnecessary to decide all of these issues, however, since (except for the Keeton patent, any issues with respect to which are now moot) there is at least one ground upon which the adverse determination with respect to each of the patents may be upheld.

A. *The Keeton Patent.*

The Keeton patent expired on March 14, 1984. Deere therefore can no longer obtain injunctive relief with respect to it. Deere admits in its reply brief that its "claim for damages arising from Kinze's infringement of the Keeton patent was released by the Settlement Agreement dated April 1, 1983." Accordingly, as Deere recognizes, any issue concerning the validity of the Keeton patent is moot.

We therefore vacate the portion of the judgment relating to the validity of the Keeton patent and remand this portion of the case to the district court for dismissal of the portion of the counterclaim relating to that patent. *See United States* v. *Munsingwear, Inc.*, 340 U.S. 36, 71 S.Ct. 104, 95 L.Ed. 36 (1950); *Gibraltar Industries, Inc.* v. *United States*, 726 F.2d 747 (Fed. Cir. 1984).

B. *The Hansen and Brass-Hansen Patents.*

During the trial, Kinze introduced some evidence that both the Hansen and Brass-Hansen inventions were "known or used by others in this country . . . before the invention . . . by the applicant." 35 U.S.C. § 102(a) (1982). In a motion for a directed verdict, Deere raised a number of specific issues it urged the court not to submit to the jury. It also included a general request for a directed verdict on Kinze's invalidity defenses, including the claim of obviousness based upon prior art not cited to the examiner. Deere, however, did not specifically refer in that motion to the prior public knowledge or use issue.

The jury answered affirmatively interrogatory 4, which asked whether the subject matter of the Hansen and Brass-Hansen patents was "publicly known or used by others in this country before the claimed invention was made by the patentee?" In its motion for judgment n.o.v., Deere contended that there was not sufficient evidence to support that jury determination. If makes the same argument here.

[1,2] Rule 50(a) of the Federal Rules of Civil Procedure requires that "[a] motion for a directed verdict shall state the specific grounds therefor." If a party fails to specify an issue in its motion for a directed verdict, it may not subsequently challenge the jury's verdict on that issue, which is conclusive on that point. *U.S. Industries, Inc.* v. *Blake Construction Co.*, 671 F.2d 539, 548 (D.C. Cir. 1982). A specific reference to the issue in a motion for judgment n.o.v. does not cure a prior failure to include the issue in the motion for a directed verdict and, thus, does not preserve the issue for appeal. *See* 9 C. Wright and A. Miller, *Federal Practice and Procedure* § 2537 (1971).

Deere contends that it could not have raised the prior public knowledge or use issue in its motion for a directed verdict because Kinze had not raised the issue until after the motion had been filed. The record does not support this contention.

On March 18, 1983, counsel for both parties met with the judge to discuss proposed jury instructions. Counsel for Deere specifically objected to proposed instruction 12, which stated (among other things) that the claimed invention "must not have been publicly known or used by others in this country before the claimed invention was made by the patentee," because "there is no evidence in the case and no contention, so far as I know, that the invention of any patent in suit was known or used by others in this country before the claimed invention was made by the patentee." Kinze's counsel disagreed, stating that

"exactly what we are contending [is] that it was known or used by others in this country. . . ." The court noted the objection but did not rule upon it.

[3] Thus, Deere was on notice as of March 18, 1983, (1) that Kinze contended that the issue of prior public knowledge or use was in the case, and (2) that the court might allow the jury to consider the issue.

On March 22, 1983, Kinze rested. The following morning Deere presented its oral motion for a directed verdict. Although the court had not yet ruled on Deere's objection to the jury instruction that included the prior public knowledge or use issue. Deere did not refer to that issue in its motion, although it specifically referred to a number of other issues. Deere's reference in the motion to prior art generally did not specifically raise this issue.

The court denied the motion for a directed verdict. Later that day it rejected Deere's objection to instruction 12. It ultimately submitted the isue of prior public knowledge or use to the jury.

In these circumstances, we hold that Deere waived its right to challenge on appeal the court's denial of its motion for judgment n.o.v. on the issue of prior public knowledge or use. Despite notice that that issue was in the case, Deere failed to preserve the point in its motion for a directed verdict, as rule 50(a) requires.

C. *The Pust Patent.*

Planters cut a furrow in the soil with two round blades called discs. The depth of the furrow is controlled by two gauge wheels which are connected to the discs, rest upon the ground, and are located on the outside of the planter. By raising or lowering the gauge wheels in relation to the discs, the farmer is able, within limits, to determine the depth of the furrow. All of these aspects of the planter were shown by the prior art.

There were two recurrent problems that Pust addressed in his invention. If soil clings to the discs, the furrow is of an uneven width and soil often caves in at the edges of the cut. Soil thrown from the discs also falls into the furrow. Both conditions result in an uneven depth of the furrow.

Pust sought to avoid these problems by moving the gauge wheels slightly behind the discs and immediately adjacent to them. This made the gauge wheels touch the discs where they leave the soil, thereby scraping off any soil stuck to the discs at that point. Placing the gauge wheels directly next to the discs also compressed the soil that constitutes the furrow walls, thus minimizing the amount of soil from the wall that can fall into the furrow. The discs, when freed from clinging soil, cut a more even furrow.

Originally Pust did not claim any specific relationship between the radius of the discs and the radius of the gauge wheels. Claim 8 (now claim 1), the only independent claim (after amendment) now in issue, then covered:

> An apparatus for forming seed planting furrows comprising:
>
> a pair of furrow forming discs,
>
> means rotably supporting said discs on intersecting axes with the peripheries of said discs substantially contacting at their point of entry into the ground and diverging apart rearwardly and upwardly relative to the direction of travel,
>
> a pair of depth gage compacting wheels in face contact with the outer surfaces of said discs,
>
> means supporting said wheels on axes parallel to, and spaced rearwardly from, the axes of said discs,
>
> said wheels extending beyond the peripheries of the discs which they contract rearwardly of the axes of said wheels relative to the direction of travel.

The examiner found claim 8 and dependent claim 9 "unpatentable over Rasmussen in view [sic] of Siems." The Rasmussen patent discloses a disc-type planter in which the gauge wheels are mounted adjacent to the discs such that the relative positions of the axes of the discs and the gauge wheels may be adjusted, thereby adjusting the dept of the furrow. The examiner explained this ruling by pointing out that "it would have been obvious to adjust the proportions of the blade and the wheel such that the wheel extends beyond the disc."

In order to overcome this rejection, the patentee narrowed the claims by specifying the radius of the gauge wheels involved. After an interview with the examiner, Pust amended claim 8 to cover only devices wherein "the radius of the wheels exceed[s] the distance from the axis [sic] of the wheels to the rear edges of the discs and [is] less than the radius of the discs." This limitation satisfied the examiner, who issued the patent with the narrowed claims.

In its answer to interrogatory 13, the jury found that, in the accused Kinze device, the radius of the guage wheel exceeded the radius of the disc. The record supports this determination. Thus, the district court justifiably concluded that Kinze's apparatus does not literally infringe the Pust patent, which claims only wheels with a radius less than that of the discs.

Deere, however, contends that it established infringement under the doctrine of equivalents because the accused Kinze planter "performs substantially the same function in substantially the same way to obtain the same result." *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 856, 94 L.Ed. 1097, 85 USPQ 328, 330 (1950). Some evidence supports Deere's contention that the size of the guage wheel is irrelevant and that the larger guage wheel is equivalent to the smaller gauge wheel.

The district court, however, applied the doctrine of prosecution history estoppel to preclude Deere from relying upon the doctrine of equivalents. Finding that Pust had intentionally narrowed his claims in order to avoid the examiner's rejection and obtain the patent, the court refused to permit Deere to avoid that limitation upon the claims through the doctrine of equivalents. The court, therefore, held that the accused Kinze device did not infringe the Pust patent.

Deere attempts to avoid the doctrine of prosecution history estoppel on the ground that Pust's limitation of his claims to devices in which the guage wheels had a smaller radius than the discs was unnecessary to distinguish the prior art. *Cf. Hughes Aircraft Co.* v. *United States,* 717 F.2d 1351, 219 USPQ 473 (Fed.Cir. 1983). Deere points out that the Rasmussen device, the prior art over which the examiner found Pust unpatentable, also contained a gauge wheel with a smaller radius than that of the discs. Thus, Deere contends, only that portion of the limitation that provided that the radius of the gauge wheels must exceed the distance from the axes of the wheels to the rear edges of the discs was necessary to render the claims patentable over Rasmussen.

We decline to undertake the speculative inquiry whether, if Pust had made only that narrowing limitation in his claim, the examiner nevertheless would have allowed it. The file on Pust's patent, to which the public had access, explicitly showed that in response to the examiner's rejection, Pust had narrowed his claims to a planter in which "the radius of the wheel . . . [is] less than the radius of the disc." Deere offers no convincing reason why a competing manufacturer was not justified in assuming that if he built a planter in which the radius of the wheels was greater than that of the disc, he would not infringe the Pust patent.

[4, 5] The doctrine of equivalents is designed to protect inventors from unscrupulous copyists, *Graver Tank,*

340 U.S. at 607, 70 S.Ct. at 855, 85 USPQ at 330, and unanticipated equivalents. *See Hughes Aircraft,* 717 F.2d at 1362, 219 USPQ at 481 ("An applicant for patent . . . is not required to predict all future developments which enable the practice of his invention in substantially the same way."). The present case, in which Kinze utilized a characteristic that the inventor specifically eliminated from his claim, is a far cry from either of those situations. Kinze did not endeavor to avoid the Pust patent by making minor immaterial changes in what Pust had invented. Instead, Kinze adopted the very element that Pust had eliminated for the stated purpose of avoiding the examiner's rejection and obtaining the patent.

Deere has not given any convincing reason why we should enlarge the literal scope of the Pust patent claims. Such enlargement would be particularly inappropriate here, where we deal with "improvement patents in a crowded art." *Hughes Aircraft,* 717 F.2d at 1362, 219 USPQ at 481.

D. *The Brass Patent.*

The Brass patent covers various elements embodied in Deere's row unit. In 1972, after the invention was embodied in a prototype planter, Deere tested the planter for 1400 hours on its private lots in Illinois and Texas.

Beginning with the 1973 planting season, Deere sought to test the warrantability, durability, and acceptability of the planter. Deere's Sales Branch, acting through local independent dealers, made planters available to farmers (called "customers" in Deere's internal memoranda) to use in planting crops. Deere instructed the dealers to keep the units moving: "If one customer is not going to be using it for a few days and another customer could, please move it."

In 1973, the farmers used the planters for 1,000 hours in five states, and in 1974, for 500 hours in 11 states. By the end of 1974, 40,000 acres had been planted with the machines.

On July 30, 1975, three years after Deere began using the invention, Deere filed the application for the Brass patent.

One of the grounds upon which Kinze challenged the Brass patent was that the farmers' testing of the planter constituted a public use of the claimed invention more than one year prior to the filing of the application. *See* 35 U.S.C. § 102(b) (1982). The jury determined that the invention had been thus "in public use" and the court held the patent invalid upon this ground.

The jury instructions treated the question of public use as a two step analysis. *But see TP Laboratories, Inc.* v. *Professional Positioners, Inc.*, 724 F.2d 965, 220 USPQ 577 (Fed.Cir.1984). First, the court instructed the jury that "any no-secret [sic] use of a completed and operative invention in its natural and intended way is a 'public use.'" Second, the court charged that

> [a]n exception to the public use provision is made were [sic] the use is one which is substantially for purposes of experimentation. However, if you find that the type of experimentation being done was primarily for commercializing the apparatus or process or toward gaining a competitive advantage or realizing a commercial gain, then such work, if it took place more than one year before the filing of applications on such alleged inventions, makes invalid any patent issuing on such applications.

Under these instructions, to which Deere did not take any exception relevant here, in order to have concluded that the invention was in public use more than a year before the application date, the jury must have found that the use of the invention was both (1) not secret and (2) principally directed toward commercializing the invention.

At oral argument Deere's counsel explicitly eschewed any contention that the farmers' testing of the machines

was not a public use because it was experimental, but "rel[ied]" solely on the claim that the farmers' use was not public because it was secret. Kinze denies that the use was secret. We find it unnecessary to resolve that question since, even if the use was secret, its commercial character made it a public use.

[6, 7] A commercial use is a public use even if it is kept secret. *Metallizing Engineering Co.* v *Kenyon Bearing and Auto Parts Co.*, 153 F.2d 516, 68 USPQ 54 (2d Cir.1946) (per L. Hand, J.); *see D.L. Auld Co.* v. *Chroma Graphics Corp.*, 714 F.2d 1144, 219 USPQ 13 (Fed.Cir. 1983) (citing *Metallizing*); 2 D. Chisum, *Patents* § 6.02[5], at 6-36 (1983) ("it is now well established that commercial exploitation by the inventor of a machine or process constitutes a public use even though the machine or process is held secret." (footnote omitted)). While secrecy is one factor to be considered in determining whether the use was experimental or public, *see TP Laboratories*, 724 F.2d at 971-72, 220 USPQ at 582, secrecy alone does not necessarily negate public use. *Id.* at 972, 220 USPQ at 583; *Metallazing*, 153 F.2d at 520, 68 USPQ at 58.

In *W.L. Gore & Associates* v. *Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed.Cir.1983), this court held that in the particular circumstances there involved, the secret use by third persons of a patented process to produce tape that those persons sold commercially, did not constitute a public use of the process which, under section 102(b), would bar a patent on the process. The court stated, however, that if those third persons "commercialized the tape, that could result in a forfeiture of a patent granted them for their process on an application filed by them more than a year later." 721 F.2d at 1550, 220 USPQ at 310 citing *Auld* and *Metallizing*).

"[A] decision on whether there has been a public use can only be made upon consideration of the entire surrounding circumstances." *TP Laboratories*, 724 F.2d at 972, 220 USPQ at 582. Considering all the circumstances

in this case, we cannot say that the jury improperly determined that Deere's testing of the machines constituted a public use even if that testing were secret.

[8] In using the machines to test them for Deere, the farmers served Deere's commercial purposes. Deere has disavowed any claim that such use was experimental. Deere used the farmers as its agents, and the testing of the machines was a commercial use by Deere of its patented invention. Since that commercial use occurred more than a year before the filing of the application for the Brass patent, section 102(b) barred the issuance of that patent.

CONCLUSION

The judgment of the United States District Court for the Northern District of Iowa is vacated insofar as it invalidated the Keeton patent, and the case is remanded to that court to dismiss as moot the portion of the counterclaim relating to that patent. In all other respects the judgment of the district court is affirmed.

AFFIRMED IN PART, VACATED IN PART, AND REMANDED.

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF IOWA
CEDAR RAPIDS DIVISION

JON E. KINZENBAW, an Individual; KINZE MANUFACTURING, INC., an Iowa Corporation,

Plaintiffs,

vs.

DEERE & COMPANY, a Delaware Corporation; EUGENE G. KEETON, an Individual,

Defendants.

NO. C 80-20

ORDER

FILED Aug. 24, 1983 9:40 A.M.

This matter is before the court on defendants' resisted motion for judgment notwithstanding the verdict (N.O.V.) or for new trial, filed April 15, 1983; on plaintiffs' resisted motions to amend judgment and for judgment N.O.V., filed April 18, 1983; and on plaintiffs' resisted bill of costs, filed April 19, 1983. Motion to amend granted in part. Remaining motions denied. Costs allowed as set forth herein.

This action for alleged violations of the patent and antitrust laws was tried to a jury in March, 1983.[1] On

[1] Trial of this action was bifurcated in such a way that the same jury would first hear and decided the patent and unfair competition claims, then return to hear and decide the antitrust issues in a second phase of trial.

This procedure had the potential of shortening a lengthy trial, reducing costs, simplifying the issues for the jury, compartmentalizing evidence, and promoting settlement upon completion of the first phase of trial. As it turned out, defendants agreed to dismiss their unfair competition claim prior to the start of the trial and a final settlement of the case was achieved following the jury's return with its decision regarding the patent phase of the case. The antitrust claims were then dismissed pursuant to the settlement agreement.

March 29, 1983, after deliberating for nearly three days, the jury returned answers to 13 special interrogatories. The court considered the jury's factual findings and, in view of the entire record, adjudged as a matter of law that Patent Nos. Keeton Re. 27,578; Hansen 3,552,601; Brass-Hansen 4,009,668; and Brass 3,982,670 are invalid and Patent No. Pust 3,499,495 is unenforceable.

JUDGMENT N.O.V.

Defendants seek judgment N.O.V. on the grounds that the jury's findings were not supported by clear and convincing evidence. Defendants also assert that the court errer by 1) submitting the "on sale" and "public use" interrogatories to the jury; 2) allowing plaintiffs' counsel to argue the law in front of the jury; 3) allowing plaintiffs' counsel to argue with adverse witnesses; 4) allowing plaintiffs to raise new defenses to infringement at trial; and 5) giving instructions 6, 12, 13, 15, 19, 20 and 21A. Defendants request the court to set aside the special interrogatories answered adversely to defendants' interests and to enter judgment in favor of defendants. In ruling on this motion, the court will only address the sufficiency of the evidence. The alleged errors by the court are more properly considered as grounds for defendants' motion for new trial, and will be discussed later.

Plaintiffs request the court to enter judgment N.O.V. and to declare that Patent No. Pust 3,499,495 was obvious to a person skilled in the art and that Patent Nos. Keeton Re. 27,578 and Brass 3,982,670, are unenforceable for misconduct before the Patent Office.

Judgment N.O.V. is proper only if reasonable persons, viewing the evidence in the light most favorable to sustaining the jury's verdict and giving the prevailing party the benefit of all reasonable inferences, could not differ as to the conclusion reached. *Kaufman* v. *Van Santen,* 696 F.2d 81, 82 (8th Cir. 1983); *Richardson* v. *Missouri Pacific Railroad Company,* 677 F.2d 633, 665 (8th Cir. 1982); *Harris* v. *Pirch,* 677 F.2d 681, 683 (8th Cir. 1982),

Here, a review of the record discloses that each factual question was genuinely contested in the record and hence, properly submitted to the jury for their consideration. It is for the jury, not the court, to resolve questions about conflicting evidence and questions as to the weight and credibility of witnesses. *Kaufman,* 696 F.2d 82. Although the jury might have found to the contrary, on any issue which it considered, it was not required to do so by the law. Moreover, as this court has previously indicated, each of the jury's findings were supported by the evidence.

Therefore, in light of the above standards, the court finds that the motions for judgment N.O.V. should be denied.

NEW TRIAL

Defendants request a new trial for the same reasons urged in support of their motion for judgment N.O.V. Plaintiffs resist, basically on the grounds that the jury's findings are supported by the evidence and because defendants have failed to show any prejudice resulting from the several errors alleged to have been committed by the court.

The district court must grant a new trial where it has determined that a jury verdict is against the clear weight of the evidence, that it is the result of passion or prejudice, or that the first trial resulted in a miscarriage of justice. *See Day* v. *Amax, Inc.,* 701 F.2d 1258, 1262 (8th Cir. 1983); *Ouachita Nat. Bank* v. *Tosco Corporation,* 686 F.2d 1291, 1294 (8th Cir. 1982); *Fireman's Fund Insurance Company* v. *Aalco Wrecking Co., Inc.,* 466 F.2d 179 (8th Cir. 1972), cert. denied, 410 U.S. 930 (1973).

Here, defendant first claims that the jury's findings are not supported by the evidence. However, as detailed by plaintiffs' resistance, there is sufficient evidence to support each of the jury's findings. The court has previously considered those findings, in conjunction with the

entire record, and ruled as a matter of law on the questions of patent validity and infringement. However, defendants have failed to establish that any of the jury's findings or any portion of the court's judgment was contrary to the clear weight of the evidence. Nor is the court convinced that there has been a miscarriage of justice or that the decision in this case is the result of passion or prejudice.

The remaining grounds for new trial urged by defendants have to do with errors allegedly committed by the court. Specifically, defendants claim that:

1.) Plaintiffs presented no evidence which would justify the court submitting questions to the jury concerning, a) "whether the subject matter of the Hansen '601 and Brass-Hansen '668 patents was publicly known or used before the inventions were made" (interrog. 4), and b) "whether the subject matter of the Hansen '601 patent was in public use or on sale in this country . . ." (interrogs. 10 and 11).

However, as indicated above, ample evidence was presented to justify submission of these questions to the jury. Further, even assuming that the court did err, such error would be harmless and would not warrant a new trial because, as a matter of law, even if the jury had found in Deere's favor on interrogatories 4, 10 and 11, the court would have found the Hansen '601 and Brass-Hansen '668 patents to be invalid as being obvious and for other reasons supported by the jury's findings.

2.) The court erroneously permitted counsel to argue the law before the jury and to argue with adverse witnesses.

Improper or intemperate argument by counsel may be grounds itself for a new trial where it tends to arouse undue passion and prejudice on the part of the jury,

thereby depriving the opposing party of a fair trial. *See Ouachita* 686 F.2d at 1295; *Harris* v. *Zurich Insurance Co.,* 527 F.2d 528, 531 (8th Cir. 1975); *Connell* v. *Steel Haulers, Inc.,* 455 F.2d 688, 692 (8th Cir. 1972); *Rochester Civic Theatre, Inc.* v. *Ramsay,* 368 F.2d 748, 754 (8th Cir. 1966).

Here, defendants have made no effort to show that they were prejudiced by statements of plaintiffs' counsel. Defendants make only conclusory allegations, rather than directing the court's attention to particular objectionable statements, and have not briefed the issue. Under such circumstances the court need not even consider the motion. *See Arteiro* v. *Coca Cola Bottling, Midwest, Inc.,* 47 FRD 186, 189 (D. Minn. 1969); *Lynn* v. *Smith,* 193 F.Supp. 887, 888 (W.D. Pa. 1961); *Leahy* v. *Travelers Ins. Co.,* 42 F.Supp. 26, 28 (S.D. Ohio 1941); FRCP 7.

Moreover, the court's independent examination of the record has not revealed any comments by counsel, on either side, which would warrant a new trial. This is true particularly in view of the court's instruction to the jury that "[S]tatements and arguments of counsel are not evidence in the case . . . you are to consider only the evidence in the case . . ."

Similarly, defendants have failed to cite any specific action by plaintiffs' counsel to support their claim that the court erroneously permitted plaintiff's counsel to engage in "various acts of impropriety."

3.) The court erroneously permitted plaintiffs to rely on defenses not raised in the pre-trial order.

When a party, over a timely objection, is permitted to introduce a defense not disclosed at the pre-trial conference a new trial should be granted only if the other party is actually surprised and prejudiced. 6A J. MOORE, MOORE'S FEDERAL PRACTICE ¶ 59.08[2] (2d ed. 1983). Further, a pre-trial order is to be liberally construed and may be modified to allow certain evidence or

claims, precluded by the pre-trial order, which become relevant by reason of development of proof at trial. *See United States* v. *First National Bank of Circle,* 652 F.2d 882, 886 (9th Cir. 1981); *Control Data Corp.* v. *International Business Machines Corporation,* 421 F.2d 323, 327 (8th Cir. 1970); *Mainbeck* v. *Ostrowski,* 384 F.2d 970, 975 (D.C. Cir. 1967), cert. denied, 390 U.S. 966 (1968).

Although plaintiffs were permitted to raise matters at trial not contained in the final pre-trial order, defendants have failed to show that they were actually surprised or prejudiced thereby. Because defendants have not specified the defenses to which they object, the court cannot address them individually. However, as a general matter, the variances from the pre-trial order were occasioned by the development of proof at trial and were allowed so as to prevent manifest injustice.

Moreover, any issue or defense first raised at trial was directly related to a patent in suit. Extensive discovery regarding those patents was performed for over three years. Thus, it is doubtful that defendants would have been able to show actual surprise or prejudice had they even attempted.

4.) The court erroneously instructed the jury in respect to instruction nos. 6, 12, 13, 15, 19, 20 and 21A, and submitted erroneous special interrogatories to the jury.

It is the complaining party's burden to establish the error in the instructions. *See Flanigan* v. *Burlington Northern, Inc.,* 632 F.2d 880, 889 (8th Cir. 1980), cert. denied, 450 U.S. 921 (1981). The submission and form of interrogatories to the jury are matters within the sound discretion of the trial court and review is confined to a determination of whether there was an abuse of discretion. *E.I. DuPont De Nemours* v. *Berkley & Co., Inc.,* 620 F.2d 1247, 1271 (8th Cir. 1980).

Again, defendants have not supported their claims of error with any argument or brief. No abuse of discretion has been shown by the court submitting interrogatories to the jury. Defendants did allege a partial lack of evidence for submitting interrogatories 4, 10 and 11, but that ground has been discussed and rejected above. The court refuses to speculate as to the specific grounds now relied on by defendants in support of finding error with the instructions and interrogatories.

For all of the above reasons, the court finds defendants' motion for new trial to be without merit and it will be denied.

MOTION TO AMEND JUDGMENT

Kinze asks the court to amend the April 5, 1983 judgment to further find that the Brass-Hansen '668 patent is unenforceable, that the Pust '495 patent is not infringed, and that Kinze is entitled to attorney fees for the patent phase of the case. Defendant resists the first two proposed amendments for the reason that they "would simply add surplusage to the judgment." The proposed amendment concerning attorney fees is resisted for the reasons that, 1) plaintiffs released their claim to attorney fees by entering into the April 1, 1983 Settlement Agreement; and 2) plaintiffs are not entitled to attorney fees as a matter of law.

Defendants' first proposed amendment was not necessary to the disposition of the case and for that reason it was omitted from the April 5, 1983 judgment. However, in the event that the Court of Appeals were to find the Brass-Hansen '668 patent valid, the additional finding would be useful in avoiding both enforcement of the patent and further litigation.

The jury's finding that the Brass-Hansen '668 patent was obtained by inequitable conduct has been upheld by this court. A patent obtained through inequitable conduct, short of fraud, may be rendered unenforceable. *See*

E.I. DuPont De Nemours, 620 F.2d at 1274. Thus, it is clear that plaintiffs are entitled to the additional finding that the Brass-Hansen '668 patent is unenforceable and the judgment will be so amended.

Plaintiffs are correct that the court found in its April 5, 1983 order that "defendants should be estopped from reading the claims of the Pust patent on the Kinze row unit." However, plaintiffs wrongfully assert that the court found infringement of the Pust '495 *patent* to be precluded by the jury's answer to special interrogatory no. 13. The court found only that the jury's answer "precludes a finding of literal infringement of the claim"[2] (emphasis added). No finding was made as to whether the Kinze row unit infringed on any of the five remaining claims contained in the patent. This is important because a patent is infringed if *any* claims of the patent are infringed. *See Marino Systems Inc.* v. *J. Cowhey & Sons, Inc.,* 631 F.2d 313, 315-16 (4th Cir. 1980). Consequently, without it having been first determined that none of the remaining claims have been infringed, the court cannot find that the Kinze row unit does not infringe on the Pust '495 patent.

The court was indirectly involved and present at the time that the parties entered into the final settlement agreement in this case and is convinced that the parties intended by that agreement[3] to put an end to any further

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[2] The claim referred to here is claim 8 of the amended patent application, filed March 29, 1968 (Exhibit DX-1002). This claim was renumbered claim 1 in the Pust '495 patent, issued March 10, 1970 (Exhibit DX-1001). The April 5, 1983 order of court referred to this claim as "claim 8 of the patent."

[3] The specific portion of that agreement which precludes plaintiffs' claim is paragraph 2. However, because the agreement is confidential, that paragraph will not be quoted here.

litigation or liabilities arising out of this case, except as may arise on appeal. This includes plaintiffs' claims for attorney fees, which, contrary to plaintiffs' assertion, did exist on or prior to the date of the Settlement Agreement.

Even if plaintiffs' claim for attorney fees would be allowed under the Settlement Agreement, that court would deny the claim. Title 35 USC § 285 provides:

> § 285. Attorney fees. The Court in exceptional cases may award reasonable attorney fees to the prevailing party.

Plaintiffs are the "prevailing party," however, this is not an "exceptional case" within the terms of the statute.

The above section should be invoked only where the losing party's misconduct was so unfair and reckless as to make it unconscionable for the prevailing party to sustain the expenses of counsel. *Lam Inc.* v. *Johns-Manville Corp.*, 668 F.2d 462, 476 (10th Cir. 1982), cert. denied, 102 S.Ct. 2298; *Q-Panel Co.* v. *Newfield*, 482 F.2d 210, 211 (10th Cir. 1973).

This case has dragged on for over three years. In that time both sides have fought hard and often advocated what appeared to be unreasonable positions. Although an "exceptional case" because of its length and because of the tenacious manner in which it was litigated, it would be unreasonable to award plaintiffs attorney fees under § 285. This is particularly true in view of the Settlement Agreement which was negotiated at the end of the first phase of trial.

COSTS

The April 5, 1983 judgment indicates that Kinze shall recover costs. He requests taxation in the amount of $153,531.31.

Initially, Deere objects to *any* taxation of costs on the ground that, under paragraph two of the Settlement Agree-

ment, such relief has already been satisfied, released and discharged.

Kinze has replied indicating the clear intent of the parties, as expressed in the third paragraph of the preamble of the Settlement Agreement, is that the parties would retain any claims they may have with respect to the patent issues, except those relating to patent misuse and certain issues relating to patent damages. Kinze also argues that the release of claims under paragraph two of the Settlement Agreement only refers to claims "existing on or at any time prior to the date of the agreement . . ." and that the judgment was not entered until four days later. Therefore, he asserts the claim for costs did not accrue until the judgment was entered and was therefore not a subject of any release under the second paragraph.

After careful review of the applicable law the court concludes that Kinze, in accordance with the April 5th judgment, should be allowed costs as to the patent issues the subject of the trial.

Under FRCP 54(d) which provides that costs shall be allowed to the prevailing party unless the court otherwise directs, federal courts have wide discretion in the apportionment and taxation of costs although it is clear that costs are generally allowed pursuant to 28 USC § 1920 as a matter of course. *Jones* v. *Schellenberger,* 225 F.2d 784 (7th Cir. 1955), cert. den., 350 U.S. 989 (1956); *Hill* v. *Gonzalez,* 53 FRD 1 (D.C. Minn. 1971). However, parties may participate in agreements which provide for the resolution of questions concerning costs. This was in fact done in this case where in paragraph nine of the Settlement Agreement the parties agreed to a dismissal of the non-patent issues in the lawsuit with prejudice and without costs. This particular agreement resulted in the order of partial judgment of April 4, 1983 signed by the court and parties.

On the other hand, the April 5th judgment, approved by the court and signed by the clerk, is a precipitation not of the Settlement Agreement but of the jury verdict. Although the Settlement Agreement appears to affect claims parties may assert under the April 5th judgment, it is clear that the costs are an incident to the judgment and, unless their taxation is specifically exempted by agreement of the parties, they should be allowed. *Southerland* v. *County of Oakland,* 77 FRD 727, 734 (D.C. Mich. 1978); *Rappenecker* v. *Sea-Land Service, Inc.,* 155 Cal. Rptr. 516, 520, 93 Cal. App. 3d 256 (1979); *Wolf* v. *Ranck,* 161 Iowa 1, 141 NW 442 (1913); *see* 20 CJS Costs § 66.

Upon careful examination of the Settlement Agreement the court notes that the release in paragraph two contains a discharge by Kinze of claims, rights and demands (and other synonyms) arising out of the allegations of the lawsuit but does not include any reference to costs. On the other hand, the agreement in paragraph nine to dismiss the non-patent issues in the case contains a specific reference to costs. Further, that paragraph exempts the patent issues from the stipulated dismissal.

The failure to specifically indicate whether costs are included in plaintiff's release even though the parties were otherwise aware and affirmatively concerned about the disposition of costs for the non-patent portion of the case, coupled with the clear indication in the preamble that the parties desire to further litigate the patent issues, results in the conclusion that Kinze did not release his claim for costs. Therefore, since there is no expression to the contrary, and regardless of when Kinze's claim for costs accrued, Kinze is allowed costs relating to the patent issues.

After careful examination of the bill of costs, objections, reply and applicable law, the court assesses costs in the amount of $15,002.62.

The fees of the clerk and the fees for service which total $64.24 are customarily allowed to prevailing plain-

tiffs and are allowed in this case. 28 USC §§ 1914, 1920(1) and 1921).

As to the requested court reporters' fees of $36,767.23 the court notes the general rule which is that the fee of the court reporter for a deposition or transcript is taxable when it was necessarily obtained for use in the case even though it may not actually have been used at trial. 28 USC § 1920(2); *Neely* v. *General Electric Co.*, 90 FRD 627, 630 (D.C. Ga. 1981). Kinze does not assist the court by showing how each of the numerous depositions and transcripts for which he seeks court reporters' fees were necessary for use in the patent portion of the case. However, the court concludes that, generally, a deposition is necessary when it is read into evidence or when a witness the subject of the deposition testifies at trial.

Thus, the fees listed for the depositions of Hansen, Feidler, Keeton, and Johnstone, all individually itemized, all unobjected to by Deere, and all deposition witnesses at the trial, are allowed.

Even though not a witness, the court further allows the fee for the Pust deposition since the fee, unobjected to by Deere, is for the deposition of the patentee of one of the patents in suit.

The total amount for these depositions is $2,838.07 and is the extent to which Deere recognizes that costs for court reporters' fees should be allowed.

Several of the requested costs for court reporters' fees are objected to on the ground that Kinze has not shown how they were necessary for use in the case. For instance, Deere objects to the $2,695.16 fee singly listed for the Brass, Wolf and Chidester depositions on the ground that the Brass deposition was not used at trial and that the fees for the Wolf and Chidester depositions, although read at trial, constitute only a fraction of the $2,695.16. Deere also objects to the $958.27 itemization for the Brass, Cuth, De Coster and Meek depositions and the

$2,245.79 itemization for the Salley, Curry, Wismer and Pauli depositions because none of these depositions were used at trial.

However, consistent with the general rule stated previously, the court allows the entire amount of $2,695.16 for the Brass, Wolf and Chidester depositions since Brass was a witness at trial. For similar reasons the court allows three-eighths of the total of the other two itemizations since three of the eight deponents were witnesses at trial. This amounts to $1,201.52. The court prefers specific itemization for each deposition, but concludes that the ends of justice are satisfied by establishing this particular allowance on a prorata basis.

The remaining depositions are objected to on the ground they are unrelated to the patent issues of the case. Even though some of these depositions involve witnesses at the trial (e.g. Hlavaty, Kinzenbaw, Murray), because Kinze initially failed to show their necessity for use in the patent portion of the case and has since failed to specifically respond to this relevance objection and provide assistance to the court in making the difficult determination as to which depositions relate to the patent trial, the court shall not allow as costs the fees for these depositions. The court notes in this regard that Jon Kinzenbaw's testimony at trial was limited by agreement of the parties and as such does not justify the taxation of the fees for any of his six depositions that are itemized.

The only remaining court reporters' fees that Kinze seeks to have assessed as costs are the fees for the transcripts of several conferences and hearings that were held before trial. However, only $122.00 for one pretrial conference is allowed. *See Sperry Rand Corp.* v. *A.-T.-O, Inc.,* 58 FRD 135, (D.C. Va. 1973). The Court notes that Kinze requests costs for two February pretrial conferences, one for $122.00 and one for $128.00. However, only one conference related to the patent issues and because it is unclear as to which figure is for that conference,

the court allows only the lesser amount. The costs for the other conferences and hearings are denied either because of insufficient description of the item or because the conferences or hearings do not relate directly to the patent issues.

Thus, the total amount allowed under the third part of the bill of costs is $6,856.75.

Kinze seeks $52,233.12 in costs relating to witness fees in the fourth portion of the bill of costs. However, the court allows only $60.00, $30.00 each for witnesses Buchele and Johnstone. 28 USC §§ 1821, 1920(e). Costs are not allowed for the other witnesses since they were neither live witnesses nor deposition witnesses whose deposition testimony was necessary to the case. *Federal Sav. & Loan Ins. Corp.* v. *Szarabajka,* 330 F.Supp. 1202, 1210 (D.C. Ill. 1971). The court disallows Buchele's fees above the statutory allowance of $30.00 since expert witness fees are generally not included as costs. *State of Illinois* v. *Sangamo Const. Co.,* 657 F.2d 855, 865 (7th Cir. 1981). In the absence of any argument to the contrary, the court is not disposed to deviate from the general rule.

In the fifth part of the bill of costs, Kinze requests costs to be assessed in the amount of $30,409.89 for fees incurred for the exemplification and copies of papers necessarily obtained for use in the case. Deere objects for the reason that much of the amount is for papers unrelated to the patent trial or for papers where it is unclear as to what aspect of the case they relate.

The court allows only those costs relating to trial exhibits used in connection with Kinze's expert witness Zarley. This amounts to $1,200.88. The remaining costs are not allowed either because they appear to be unrelated to the patent issues or because the description of the items are merely conclusory and insufficient for the court to make a proper determination of costs, or both.

In the sixth part of the bill of costs Kinze requests that $17,931.75 be assessed as costs incident to the taking of

depositions. Deere objects claiming that Kinze is merely seeking unrecoverable travel expenses. In addition Deere maintains the depositions were not necessary and were unrelated to the patent issues.

The court allows only $40.00 of these requested costs. It is clear the attorneys' travel expenses, comprising the overwhelming portion of the request, are not to be included. *Kiefel* v. *Las Vegas Hacienda, Inc.*, 404 F.2d 1163, 1170 (7th Cir. 1968), cert. den., 395 U.S. 908 (1969); *Frigiquip Corporation* v. *Parker-Hannifan Corporation*, 75 FRD 605, 615 (W.D. Okla. 1977). The other costs sought to be assessed are for marshal fees, service of subpoenas, deposition filing fees and travel expenses for deposition witness Pust. The first three of these four items are denied because, regardless of whether they are normally allowable as costs, Kinze fails to show to what depositions these costs are related such that the court, in light of Deere's objections, cannot make a proper determination as to whether they are connected with the patent issues.

The court does allow $40.00 of the request for $917.04 for Pust's travel expenses even though the mode or distance of travel is unclear. The amount was obtained by multiplying the present allowable per mile rate of 20¢ for travel by privately owned vehicle by 200 miles (100 miles round trip). 28 USC § 1821(c)(2); *Linneman Const. Inc.* v. *Montana-Dakota Utilities Co., Inc.*, 504 F.2d 1365, 1371 (8th Cir. 1974). Although it could be that Pust traveled by common carrier where he may not necessarily be limited by the 100 mile rule, the receipt or its equivalent that is required by statute has not been supplied to the court. 28 USC § 1821(c)(1); *see Oscar Gruss and Son* v. *Lumbermens Mut. Cas. Co.*, 46 FRD 635, 639 (D.C.N.Y. 1969). Despite the lack of clarity, the court concludes the $40.00 assessment is in the interest of justice.

Kinze seeks $9,656.73 in "other costs." Deere objects claiming these costs are not authorized by statute and

that several of them are not attributable to the patent issues.

Initially, the court recognizes that it has the power to assess costs for items which are not specifically mentioned by statute although its discretion to do so should be sparingly exercised. *Com. of Pennsylvania* v. *O'Neill,* 431 F.Supp. 700 (D.C. Pa. 1977). However, it only allows the $312.00 listed for the patent office expenses which appear to be in the nature of fees for exemplification and copies of papers necessarily obtained for use in the case. The other costs relating to Federal Express, investigation, postage, telephone tools and supplies for trial are not recoverable expenses under 28 USC § 1920. *Wahl* v. *Carrier Manufacturing Co., Inc.,* 511 F.2d 209, 218 (7th Cir. 1975); *Twentieth Century Fox Film Corp.* v. *Goldwyn,* 328 F.2d 190, 224 (9th Cir.), cert. den., 379 U.S. 880 (1964); *Dowdell* v. *City of Apopka, Fla.,* 521 F.Supp. 297, 306 (M.D. Fla. 1981); United *States* v. *Vaughn,* 636 F.2d 921, 923 (4th Cir. 1980); *Esler* v. *Safeway Stores, Inc.,* 77 FRD 479, 482 (D.C. Mo. 1978).

The final request by Kinze is for $6,468.75 in trial transcript costs. Unobjected to by Deere the court allows the entire amount. 28 USC § 1920(2); *Galella* v. *Onassis,* 487 F.2d 986, (2nd Cir. 1973).

It is therefore

ORDERED

1. Judgment notwithstanding the verdict denied.

2. New trial denied.

3. Judgment amended to declare patent No. Brass-Hansen 4,009,668 both invalid and unenforceable.

4. Costs are assessed against defendants in the amount of $15,002.62.

August 24, 1983.

/s/ Edward J. McManus
Edward J. McManus, Chief Judge